

### **REMARKS**

The Examiner objected to the drawings.

The Examiner rejected claims 29-31 under 35 U.S.C. §101 as allegedly lacking patentable utility.

The Examiner rejected claims 29-31 under 35 U.S.C. §103(a) as allegedly being unpatentable over Gundewar et al. (US Patent 6,381,610) in view of Examiner's Official Notice.

Attached herewith is a Declaration under 37 C.F.R. §1.132.

Applicants respectfully traverse the drawing objections and the rejections under 35 U.S.C. §101 and 35 U.S.C. §103(a) with the following arguments.

### **Drawing Objections**

The Examiner objected to the drawings, alleging (in the prior office action mailed June 2, 2003) that “The drawings must show every feature of the invention specified in the claims. Therefore, the claimed program storage device with claimed method steps must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.”

In Applicants’ prior response to said drawing objections, Applicants added FIG. 7 which included the claimed storage device. However, in a telephone communication between the Examiner and Applicants’ representative on 11/21/2003, the Examiner indicated that the drawings are still objected to because of lack of a flow chart which illustrates the claimed method steps. In response, Applicants have added FIGS. 8 and 9 by amendment herein. FIG. 8 is a flow chart that illustrates the claimed method steps of claims 29 and 30. FIG. 9 illustrates claim 31. Applicants have also amended the specification to describe FIGS. 8 and 9. Applicants assert that no new matter has been added by FIGS. 8 and 9 or by said amendment to the specification.

In addition, Applicants respectfully contend that the claimed subject matter is illustrated in originally filed drawings. In particular, claims 29-31 claim “maintaining a playbook database ...”, and the playbook database 70 appears in FIG. 1. Claims 29-31 claim “displaying a playbook summary view ...”, and the playbook summary view 400 appears in FIG. 4. Claims 29-31 claim “displaying a summary task template ...”, and the summary task template 440 appears in FIG. 5. Claims 29-31 claim “displaying a detailed task template ...”, and the detailed task template 520 appears in FIG. 6.

Applicants respectfully believe that the amendment herein overcomes the drawing objections. Accordingly, Applicants request that the drawing objections be withdrawn. However, if the Examiner considers the drawing objections to not have been fully removed by the amendment herein, then Applicants respectfully request that the Examiner contact Applicants' representative, Jack Friedman, by telephone to discuss any remaining drawing objections.

### **35 U.S.C. §101**

The Examiner rejected claims 29-31 under 35 U.S.C. §101 as allegedly lacking patentable utility. The Examiner alleged: “Claims 29-31 are rejected because they lack patentable utility. Claims 1-9 only claim the manipulation of data but perform no concrete, useful or tangible result”.

Applicants note that the Examiner’s argument in support of the rejection of claims 29-31 under 35 U.S.C. §101 is formulated in terms of 1-9. However, claims 1-9 have been cancelled. Since claims 29-31 differ significantly from claims 1-9, Applicants maintain that the rejection of claims 29-31 based on arguments against claims 1-9 is improper. Therefore, Applicants request withdrawal of the rejection of claims 29-31 under 35 U.S.C. §101.

Applicants next present reasons why claims 29-31 do not lack patentable utility, even though claims 29-31 were not rejected under 35 U.S.C. §101.

As a first reason why claims 29-31 do not lack patentable utility, Applicants note that claims 29-31 are in a “Beuregard” format via the language: “A program storage device readable by a machine, tangibly embodying a program of instructions executable by a machine to perform method steps for ..., said method steps comprising ...”. Case law has long ago established that a Beuregard claim is patentable.

As a second reason why claims 29-31 do not lack patentable utility, claims 29-31 recite a “program of instructions executable by a machine to perform method steps for coordinating a

project for designing, implementing, and using a general procurement and accounts payable (GP/AP) system for a customer”, which is useful, concrete, and tangible at least because “designing, implementing, and using a general procurement and accounts payable (GP/AP) system for a customer” is useful, concrete, and tangible.

Applicants note that the aforementioned reference to a GP/AP system and to a customer appears not only in the preamble of claims 29-31, but also within the claim elements, namely: “a plurality of templates of information relating to said designing, implementing, and using said GP/AP system, said plurality of templates being particularized for the customer” in the “maintaining a playbook database” step.

As a third reason why claims 29-31 do not lack patentable utility, Applicants note that the method steps in claims 29-31 perform maintaining a database and displaying various views and templates, and it is routine practice for the United States Patent and Trademark Office (USPTO) to allow and issue patent with similar or analogous claims. Indeed, the very reference of Gundewar cited by the Examiner is replete with similar or analogous claims to claims 29-31 of the present patent application with respect to utility under 35 U.S.C. §101. In fact, Gundewar’s claims are not even in a Beuregard format; i.e., the displaying and other data manipulation recited in Gundewar’s claims are not recited as being executed or executable by a machine in accordance with a program of instructions. Yet, Gundewar’s patent has been issued and the claims therein are presumed to be patentable. Applicants would have no difficulty in citing many other issued patents having claims similar or analogous to claims 29-31 from the vantage point of utility under 35 U.S.C. §101. Applicants respectfully submit that the USPTO issues such patents regularly,

because such patents are permitted under established case law.

As a fourth reason why claims 29-31 do not lack patentable utility, Applicants have submitted herewith a Declaration under 37 C.F.R. §1.132. As stated in said Declaration, the assignee International Business Machines Corporation (IBM) paid over \$500,000 to develop software which implements the subject matter described and claimed in the present patent application, wherein said software package includes program code comprising the claimed subject matter of claims 29-31. Applicants respectfully contend that the fact that IBM paid over \$500,000 to develop the software and continues to maintain the software through the present date and into the future supports Applicants' contention that claims 29-31 do not lack patentable utility.

Accordingly, Applicants respectfully contend that claims 29-31 are not unpatentable under 35 U.S.C. §101.

**35 U.S.C. §103(a)**

The Examiner rejected claims 29-31 under 35 U.S.C. §103(a) as allegedly being unpatentable over Gundewar et al. (US Patent 6,381,610) in view of Examiner's Official Notice.

The Examiner argues: "Gundewar et al. discloses the claimed device but does not explicitly claim "buttons" for selecting tasks of categories. Examiner takes official notice that selection buttons are notoriously old and well known in the art of computer operating systems (such as used in a Window's interface) in order to make it easy for a user to select an item from a list. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the program storage device of Gundewar et al.... Gundewar et al. discloses a program storage device readable by a machine, tangibly embodying a program of instructions executable by a machine to perform method steps for coordinating a project for designing, implementing, and using a general procurement and accounts payable system for a customer, the method comprising: maintaining a playbook database (such as database containing project, task, template and guideline data); and displaying a playbook summary view with folders and views section (such as access to project, 100), a task title display and selection area (such as when the system displays project task selection window, 110), a summary task creation selection with display (such as when prompted to select a template, 180), and a detailed task creation button with display (such as when prompted to select the display guidelines 195)."

Applicants respectfully contend that claim 29 is not unpatentable over Gundewar in view of Examiner's Official Notice, because Gundewar in view of Examiner's Official Notice does not teach or suggest each and every feature of claim 29.

As a first example of why Gundewar in view of Examiner's Official Notice does not teach or suggest each and every feature of claim 29, Gundewar in view of Examiner's Official Notice does not teach or suggest the "GP/AP system" aspect of the feature "said playbook database comprising a plurality of templates of information relating to said designing, implementing, and using said **GP/AP system**" (emphasis added). Gundewar does not teach or suggest using his disclosed templates in conjunction with a GP/AP system.

As a second example of why Gundewar in view of Examiner's Official Notice does not teach or suggest each and every feature of claim 29, Gundewar in view of Examiner's Official Notice does not teach or suggest the "implementing, and using" aspect of the feature "said playbook database comprising a plurality of templates of information relating to said designing, **implementing, and using** said GP/AP system" (emphasis added). Gundewar's disclosure is restricted to templates for "planning" aspects of a project. Gundewar does not teach or suggest templates for "implementing, and using" aspects of a project. All of the templates discussed and disclosed by Gundewar relate to project planning, and none of the templates discussed and disclosed by Gundewar relate to "implementing, and using" aspects of a project. For example, see col. 4, lines 38-41: "The project task template includes a list of major project tasks that may be associated with Project X and that are organized according to various stages of **project planning**." (emphasis added).

As a third example of why Gundewar in view of Examiner's Official Notice does not



teach or suggest each and every feature of claim 29, Gundewar in view of Examiner's Official Notice does not teach or suggest the feature: "said plurality of templates being particularized for the **customer**" (emphasis added). Applicants contend that Gundewar's templates are particularized for a project, and Gundewar does not teach or suggest that the templates are particularized for a customer.

As a fourth example of why Gundewar in view of Examiner's Official Notice does not teach or suggest each and every feature of claim 29, Gundewar in view of Examiner's Official Notice does not teach or suggest the feature: "displaying a playbook summary **view**, said playbook summary **view** comprising a folders and views section, a task title display and selection area, a summary task creation button, and a detailed task creation button" (emphasis added). What the Examiner alleges to be a folders and views section, a task title display and selection area, a summary task creation button, and a detailed task creation button is not disclosed by Gundewar as sections or portions of a view as required by claim 29, but rather is disclosed as appearing in separate and distinct windows or views in violation of said requirement of claim 29. For example, the Examiner alleges that step 100 of FIG. 4 of Gundewar discloses a folders and views section of the "view". The Examiner alleges that step 110 of FIG. 4 of Gundewar discloses task title display and selection area, but Gundewar does not teach or suggest in col. 8, lines 21-23 that the alleged task title display and selection area of step 110 is displayed in the same view as is the task title display and selection area of step 100, as required by claim 29. The Examiner alleges that a prompt to select a template in step 180 of FIG. 4 of Gundewar discloses a summary task selection (which the Examiner alleges may be obviously in the form of a button), but Gundewar states in

col. 8, lines 39-42 that the template in step 180 is selected from a displayed procedure data sheet and not from the view which displays the folders and views section and the task title display and selection area, as required by claim 29. The Examiner alleges that a prompt to select guidelines in step 195 of FIG. 4 of Gundewar discloses a detailed task selection (which the Examiner alleges may be obviously in the form of a button), but Gundewar in col. 8, lines 44-46 states that the template in step 195 results from selection of a template from the displayed procedure data sheet and not from the view which displays the folders and views section and the task title display and selection area, as required by claim 29.

As a fifth example of why Gundewar in view of Examiner's Official Notice does not teach or suggest each and every feature of claim 29, Gundewar in view of Examiner's Official Notice does not teach or suggest the feature: "said folders and views section including category buttons relating to categories of tasks associated with said designing, implementing, and using said GP/AP system". The Examiner alleges that step 100 of FIG. 4 of Gundewar discloses a folders and views section, but all that Gundewar discloses in col. 8, lines 15-21 for step 100 is that a user may access a particular project. Thus step 100 presents a view of selectable projects, but does not present a view of selectable categories of tasks, as required by claim 29.

As a sixth example of why Gundewar in view of Examiner's Official Notice does not teach or suggest each and every feature of claim 29, Gundewar in view of Examiner's Official Notice does not teach or suggest the feature: "displaying a **summary task template** of the plurality of templates for a selected first task of the tasks identified in the task title display and

selection area, said summary task template being displayed in response to a selection of the summary task creation button, said summary task template including summary parameters of the selected first task” (emphasis added). The Examiner alleges that a prompt to select a template in step 180 of FIG. 4 of Gundewar discloses a summary task creation selection (which the Examiner alleges may be obviously in the form of a button). However, claim 29 requires more specificity than mere displaying of a template. Claim 29 recites “displaying a **summary** task template”, and in col. 8, lines 39-42 Gundewar states only that a template is selected from the procedure data sheet and subsequently displayed. Gundewar does not disclose that a **summary** template is selected from the procedure data sheet and subsequently displayed, as required by claim 29.

As a seventh example of why Gundewar in view of Examiner’s Official Notice does not teach or suggest each and every feature of claim 29, Gundewar in view of Examiner’s Official Notice does not teach or suggest the feature: “displaying a **detailed task template** of the plurality of templates for a selected second task of the tasks identified in the task title display and selection area, said detailed task template being displayed in response to a selection of the detailed task creation button, said detailed task template including detailed parameters of the selected second task” (emphasis added). The Examiner alleges that a prompt to select a guidelines in step 195 of FIG. 4 of Gundewar discloses a detailed task selection (which the Examiner alleges may be obviously in the form of a button). However, claim 29 requires that a detailed task template be displayed, and in col. 8, lines 44-46 Gundewar states only that guidelines are presented to the user as a result selecting a “particular template”, but does not disclose displaying a **detailed** task template, as required by claim 29.

Based on the preceding arguments, Applicants respectfully maintain that claim 29 is not unpatentable over Gundewar in view of Examiner's Official Notice, and that claim 29 is in condition for allowance. Since claims 30-31 depend from claim 29, Applicants contend that claims 30-31 are likewise in condition for allowance.

In addition with respect to claim 30, Applicants respectfully contend that Gundewar in view of Examiner's Official Notice does not teach or suggest the following feature of claim 30: "enabling communication between team members of a team and the playbook database via a server coupled to the playbook database and an intranet coupled to both the server and the team members, said team members having responsibility for said designing and implementing of said GP/AP system". Applicants note that the Examiner has not presented an argument to support the Examiner's allegation that Gundewar in view of Examiner's Official Notice teaches or suggests the aforementioned feature of claim 30.

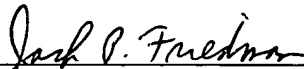
In addition with respect to claim 31, Applicants respectfully contend that Gundewar in view of Examiner's Official Notice does not teach or suggest the following feature of claim 31: "wherein a template of the plurality of templates includes or is linked to an item selected from the group consisting of a document, an instruction, a flow chart, a sample questionnaire, a report model, and a checklist, said item being pertinent to guiding, coordinating and documenting work of a team member of the team." Applicants note that the Examiner has not presented an argument to support the Examiner's allegation that Gundewar in view of Examiner's Official Notice teaches or suggests the aforementioned feature of claim 31.

### CONCLUSION

Based on the preceding arguments, Applicants respectfully believe that all pending claims and the entire application meet the acceptance criteria for allowance and therefore request favorable action. If the Examiner believes that anything further would be helpful to place the application in better condition for allowance, Applicants invites the Examiner to contact Applicants' representative at the telephone number listed below.

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